

REMARKS

This responds to the Office Action mailed on January 9, 2004.

By this amendment, no claims are amended, canceled, or added. As a result, claims 1-12, 15-18, 21-29 and 31-34 remain pending in this application. Reconsideration of this application is requested in view of the below remarks.

§112 Rejection of the Claims

Rejection: Claims 1-12, 15-18, 21-29 and 31-34 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement.

Response:

A) Applicable Law

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. (See MPEP § 2164)

The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. (See MPEP § 2164)

The specific test for enablement is set forth in MPEP § 2164.01. According to MPEP § 2164.01, Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re*

Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). (See MPEP § 2164.01)

MPEP § 2164.01 also states that "A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984)." (See MPEP § 2164.01)

The standard therefore is whether the disclosure of an application is sufficient to inform those skilled in the relevant art how to both make and use the claimed invention without undue experimentation.

MPEP § 2164.01(a) sets forth factors which are to be considered with respect to undue experimentation. The factors include but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement). [See MPEP § 2164(a)].

In addition, the burden is on the Examiner under the enablement requirement according to MPEP § 2164.04. According to MPEP § 2164.04 “In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).” (See MPEP § 2164.04, emphasis added).

B) Argument: The Rejection under 35 USC § 112, first paragraph is improper

The burden of establishing a rejection based on a lack of enablement sits squarely with the Examiner, according to MPEP § 2164.04. In order for a rejection to be proper under 35 USC § 112, first paragraph, the Examiner must apply the above standards. Simply put, the Examiner has not applied the above standards and therefore the rejection is improper.

In the second office action, dated January 9, 2004, the Examiner agrees that “...Figure 11 clearly shows a rack and pinion arrangement for moving the oval pins.” (See paragraph 2, page 2 of the Office Action dated January 9, 2004). The Examiner’s position is that Figure 11 is not related to the elected species. This position is simply wrong.

Figure 11 is related to the embodiment of the invention shown in Figures 5A and 5B. According to the brief description of the drawings, “Figure 6A is a side view of the surface mount component/connector of Figure 5A...” The cut line (11-11) in Figure 6A is the view that forms Figure 11. Therefore, the specification clearly relates Figure 11 to the elected species, namely the species of Figure 5.

In addition, the MPEP states that “A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (See MPEP § 2164.04). Since the Examiner agrees that Figure 11 clearly shows a rack and pinion arrangement for moving the oval pins and since the Examiner has not stated a reason to doubt the objective truth of the statements contained in the specification, the Examiner has to recognize that the enablement requirement is met per MPEP § 2106.04. In other words, by the Examiner’s own admission, the specification disclosure contains a teaching of making and using the invention. The Examiner does not include a reason to doubt the truth of the statements within the specification. Therefore, the specification is enabling. The rejection under 35 USC § 112, first paragraph, is improper.

In addition, the Examiner also failed to apply the standards set forth in the MPEP. All the tests of enablement consider the entire specification. No test of enablement is set forth

allowing the specification to be sliced into various portions related to the various species of the invention. Even if there was such a test of enablement, the Examiner still has failed to apply the standards set forth in the applicable law set forth above. At best, the Examiner has merely made a conclusory and unsupported statement related to enablement. The Examiner has not supported his position with any analysis, much less the analysis required by the MPEP in the above stated portions of applicable law.

For example, analysis of the following factors set forth in MPEP § 2164.01(a) would show enablement without undue experimentation:

- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

For example, one of ordinary skill in the art would look at the disclosure as a whole. The one of skill in the art will not separate the disclosure based on species. One of skill in the art has no concept of species and the fine points of patent law and therefore would not place an artificial barrier in his or her path when reading the disclosure. Even if the Examiner's position was correct, one of ordinary skill in the art would certainly look to the disclosure and see that Figure 11 shows how the pins of Figure 5A and 5B are rotated (Fig. 6A is a side view of Figure 5A and cut line 11-11 in Figure 6A details the rotation). Applicant contends that this would be the first place one of ordinary skill in the art would look, namely at the entire content of the disclosure (factor H), and to the working of existing examples (factor G). The content of the entire disclosure also speaks to the amount of direction provided by the inventor (factor F).

In conclusion, the Examiner's rejection of claims 1-12, 15-18, 21-29 and 31-34 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement is overcome. Simply put, the Examiner failed to properly analyze the disclosure as required by MPEP 2164 and specifically by the sections of the MPEP set forth above. One of ordinary skill in the art would look to the entire disclosure for direction on how to build the device and allow one of ordinary skill in the art to do so without undue experimentation. In addition, the Examiner has agreed that Figure 11 agrees clearly shows a rack and pinion arrangement for moving the oval

pins. Since the Examiner has not stated a reason to doubt the objective truth of the statements contained in the specification, the Examiner has to recognize that the enablement requirement is met per MPEP § 2106.04.

Finally, the Examiner is simply wrong in stating that Figure 5 is not related to Figure 11 when the description of Figure 6A relates it to Figure 5A and the cut line shown in Figure 6, directs the reader to Figure 11 for details. Original Figures 5B and 6B include arrows which indicate that the pins 31, 32, 33, 36, 37 and 38 are moved. Figure 5B also includes a lever. An arrow in Figure 5B indicates movement of the lever (element 45). Figure 6A is related to Figure 5A, as indicated in the brief description of the drawings. Original Figure 11 is taken along section line 11-11 in original Figure 6. Figure 11 shows a sliding plate 65 having rectangular openings 66, 67, which are provided with rack gear teeth sets 78, 79 which engage the pinion gear portion 75 of at least one of the connectors 31. (See Original Figures 10A, 10B, 10C and 11). Each of the pins 31, 32, 33, 36, 37, 38 include a gear portion 75, 76, 77, 80, 81, 82. (See bottom of page 12 and top of page 13 of the specification). The specification also indicates that a cam or screw could also be used to move the plate 65. (See end of first paragraph on page 13). The specification (written portion and the figures), therefore, shows multiple ways to move the pins 31, 32, 33, 36, 37, 38 and also a specific embodiment sufficient to enable one skilled in the art to make and use the invention without undue experimentation.

Miscellaneous Remarks

In addition, applicant contends that there is one or more generic claims in the case. Claims 1, 10, 15, 25 and 28 all appear to be generic to all species set forth previously. In the alternative, new claim 31 is generic and covers all species of the invention.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/032329

Filing Date: December 31, 2001

Title: Zero Mounting Force Solder-free Connector/Component and Method

Assignee: Intel Corporation

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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